

REMARKS/ARGUMENTS

The Office is requiring restriction to one of the following groups:

- Group I: Claims 19-28, 31, and 32, drawn to peptide molecules that interferes with an HLH domain of TAL-1;
- Group II: Claims 29, 30, 33, and 34, drawn to a method of preventing and/or treating diseases related to angiogenesis; and
- Group III: Claims 35-37, drawn to a method for identifying a biologically active compound likely to be used in prevention and/or treatment of diseases related to angiogenesis.

In response to the Restriction Requirement mailed March 11, 2009, Applicants elect, with traverse, Group I, Claims 19-28 and 31-32, for examination. Furthermore, Applicants provisionally elect with traverse for examination purposes only Species III: SEQ ID NO. 1 (encompassed by at least Claims 19-28 and 31-32).

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office has alleged that Groups 1-3 do not relate to the single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special features for the following reasons:

According to PCT Rule 13.2, unity of invention exists only when there is a shared same or corresponding special technical feature among the claimed inventions. Here, Group III did not require the use of, or make the products of, Group I, and thus the claims lack unity.

According to PCT Rule 13.2, unity of invention exists only when the shared or corresponding technical feature is a contribution over the prior art. Here, Applicant states in paragraph [0008] (spanning pages 3 and 4 of the specification file 11/16/06), "Peptide inhibitors able to enter into competition with the HLH domain of TAL-1 have also been developed. These peptide inhibitors were then coupled with peptide vectors to enable and/or improve their internalization in the cells. This work is described in FR 97/10297, filed on 08 December 1997." Thus the technical feature is not a contribution over the art, as FR 97/10297 teaches equivalent sequences, in that they have the same function and the claims lack utility.

Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states, emphasis added:

The expression "special technical feature" is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, *considered as a whole*, makes over the prior art. The determination is made on the contents of the claims as *interpreted in light of the description* and drawings (if any).

Applicants respectfully submit that the Office did not consider the contribution of each invention, *as a whole*, in alleging the lack of a special technical feature. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims *interpreted in light of the description* were considered in making this allegation. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

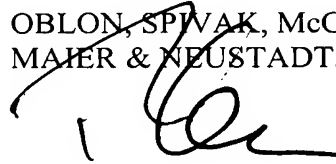
In regard to the election of species, Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP § 808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Registration No. 36,379

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)